

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William T. Jennings
U.S. Patent Serial No.: 09/668,026
Filing Date: September 21, 2000
Examiner: Christian A. Laforgia
Art Unit: 2131
Title: KEY ESCROW SYSTEMS
Attorney Docket Number: 064751.0298

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre- Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, Applicant submits the following brief summary of selected portions of the prosecution history of the Application.

I. Brief Summary of Selected Portions of Prosecution History

a. Final Office Action

In a Final Office Action of April 8, 2005 (the Final Office Action), all claims were rejected under 35 U.S.C. § 103, but as described in further details below, the Final Office Action failed to set forth a *prima facie* rejection of several of the claims.

Accordingly, Applicant filed a Response to the Final Office Action on August 4, 2005 (the Response to Final Office Action). In this response the Applicant pointed out that the Final Office Action did not establish a *prima facie* rejection of the claim under 35 U.S.C. § 103, and requested that the claims be allowed. See Response to Final Office Action, pages 20-23.

b. Advisory Action

In an Advisory Action of September 8, 2005 (the Advisory Action), the Examiner maintained the rejection of Claims 1-24 and 26-36, with the following response:

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *in re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *in re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references themselves provide a teaching, suggestion, and motivation to combine the references with a reasonable expectation of success as cited in the office action.

Advisory Action, page 2.

II. Errors of Record

a. Failure to Establish a Prima Facie Rejection

Applicant maintains that the Final Office Action did not establish a *prima facie* rejection of all the claims in the application and that the Advisory Action did not address the deficiencies pointed out by the Applicant in the Response to the Final Office Action.

First, as Applicant showed in the Response to the Final Office Action, the cited references, alone or in combination, fail to disclose, teach or suggest each element of the independent claims 1, 6, 14, 28, and 33. *See* Response to Final Office Action, page 21. As Applicant pointed out in the Response to the Final Office Action, the *Merkle-Ford* combination do not disclose “adding randomization information at the receiver to the corresponding token of the selected trap door encryption-decryption function pair” or “encrypting the token with the added randomization information at the receiver . . . ,” as required by Claim 1. *See* Response to Final Office Action, page 21. Applicant further pointed out that the *Merkle-Ford* combination does not disclose similar limitations in Claim 6, 14, 28, and 33. *See* Response to Final Office Action, page 23. The Advisory Action, quoted above, does not address the failure of the *Merkle-Ford* combination to show each of the elements of the independent Claims.

Second, with respect to dependant claims 3, 7, 20, 22, 30, 34, and 36, Applicant pointed out that a portion of the Examiner’s cited obviousness determination was not supported by affidavit of personal knowledge or any citation to a reference. *See* Response to Final Office Action, pages 22-23, quoting Final Office Action, pages 4-5. Applicant maintains that the Advisory Action does not correct the deficiencies in the Final Office Action, as a portion of the rejection of claims 3, 7, 20, 22, 30, 34, and 36 is still not supported by any reference or affidavit of the Examiner’s personal knowledge.

Third, with respect to each of the independent claims 1, 6, 14, 28, and 33 (and each claim that depends from the independent claims), Applicant maintains that the cited motivation for combination of the references is improper. *See* Response to Final Office Action, pages 21-22. Applicant maintains that the Advisory Action does not correct the deficiencies noted in the Response to Final Office Action at pages 21 and 22. The citation of the “Object of The Invention” section of *Ford*, at most, shows a purported advantage of using the system discussed in *Ford*, but does not show how a person of ordinary skill in the art would be motivated to apply the discussion of *Ford* to *Merkle*. *See* Response to Final Office Action, pages 21-23.

II. Request for Relief from Errors

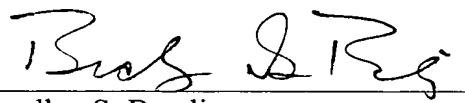
As a *prima facie* rejection has not been established against Claims 1-24 and 26-36, Applicant respectfully requests allowance of Claims 1-24 and 26-36.

CONCLUSION

For the reasons presented above, Applicant respectfully requests relief from the Errors of Record. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Bradley S. Bowling
Reg. No. 52,641

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Correspondence Address:

Customer Number: 05073